

Claim 1 recites an image data processing system that comprises a digital camera that includes a selection means that selects between a first memory section and a second memory section for selectively storing the image data.

The Examiner's rejection is essentially the same as that given in the Office Action of February 25, 2005. The Examiner contends that Applicant's arguments, in the response of June 27, 2005, that the claimed selecting means (switch) as set forth in the independent claims is not inherent since camera 100 of Safai stores the images in internal memory 212 are not persuasive. The Examiner contends that because camera 100 can store images in internal memory 212 and an external memory 614, there must inherently be a selection circuit. Office Action at page 2.

"All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). Here, the Examiner, in interpreting claim 1, ignores the word "selectively."

Safai, a most, discloses that images stored in storage 212 of camera 100 may be copied to storage 614 of server 601 by using transport program 230 (see col. 8 lines 37-47, col. 10, lines 26-39 and col. 13, lines 10-32). Therefore, only images that have previously been stored in storage 212 (the alleged first memory) are copied to storage 614 (the alleged second memory). Therefore, because the teachings of Safai suggest that all the images are first stored in camera 100, Applicant submits that Safai does not disclose or suggest "selectively storing the image data" as set forth in claim 1. (emphasis added).

The fact that the image data may be later copied or transferred to other devices is not relevant to the issue at hand since these operations do not correspond to selecting between a first

memory section and a second memory section for selectively storing the data. In fact, both storage devices must be selected in order for the copying between storages 212 and 614 to work, not a selection between the two storage devices.

Because merely copying the data from one storage device to another would not correspond to the claimed selective storage, the claimed selection means is not inherent to the system in Safai. Therefore, Safai does not disclose or suggest at least the claimed selection means as set forth in claim 1.

Because claims 5, 15 and 19 recite features similar to those given above with respect to claim 1, Applicant submits that these claims are patentable for at least reasons similar to those given above with respect to claim 1.

Applicant submits that the remaining claims are patentable at least by virtue of their respective dependencies.

2. Claim Rejection Under 35 U.S.C. § 103

The Examiner has rejected claims 4 and 18 under 35 U.S.C. § 103(a) as being unpatentable over Safai. For at least the following reasons, Applicant traverses the rejection.

The Examiner concedes that the subject matter of these claims is not disclosed by Safai, but the Examiner has taken Official Notice that a camera can be connected to a plurality of printers.

Applicant submits that claims 4 and 18 are patentable at least by virtue of their respective dependencies.

In addition, Applicant submits that, at the time of the invention, Applicant was not aware of any commercial products in which a camera could be connected to a plurality of printers or of any publications that disclosed this feature. Applicant also submits that the claimed feature is not obvious. Applicant requests that the Examiner provide evidence in the record that the claimed feature would have been obvious to one skilled in the art at the time of the invention.

Further, Applicant submits that that it is never appropriate for the Examiner to take Office Notice of technical facts in areas of esoteric technology without citation to a recognized reference. See MPEP at 2100-136. In this case, the design of communication circuits for digital cameras would qualify as esoteric technology.

Finally, the Examiner previously cited Fukuoka (US 5,754,227) as allegedly making obvious the claimed subject matter. Therefore, the Examiner, at one point, did not believe that the subject matter of claims 4 and 18 qualified as being “capable of instant and unquestionable demonstration as being well-known” (pre-requisite for an Official Notice).

However, rather than respond substantively to Applicant’s arguments that one skilled in the art would not have combined the teachings of Sakai and Fukuoka, the Examiner now drops the Fukuoka reference and takes Official Notice. Applicant submits that this shift in the Examiner’s rejection is highly improper and requests that the rejection of claims 4 and 18 be withdrawn.

3. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the

Response under 37 C.F.R. § 1.111
U.S. Serial No. 09/534,206

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Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

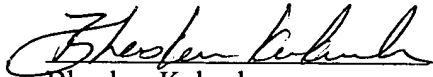
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